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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,791	04/20/2001	Rocco D'Antonio	1139	2557

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EXAMINER

PASCUA, JES F

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 05/02/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,791

Applicant(s)

D'ANTONIO, ROCCO

Examiner

Jes F. Pascua

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7 and 10-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-7 and 10-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/3/03 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-7 and 10-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 11 and 12 recite "a paper container made of a grade of paper of lighter weight than that used for standard paper grocery sacks of similar base perimeter". Since paper grocery sacks (or paper sacks having a base perimeter similar to that of grocery sacks) are made of different weights, it cannot be determined what weight or weights the claims require. It is apparent that one of ordinary skill in the art would recognize that there is some limit to the weight of paper included in these claims, but

Art Unit: 3727

would not be able to determine, with any degree of certainty or precision, the particular limits of the weight recited in the claims so as to ascertain the metes and bounds of the claims.

Furthermore, claims 2, 11 and 12 recite a paper liner whose base "perimeter is approximately equal to the base perimeter of standard plastic grocery sacks" and with "a height approximately equal to the height to the collar of standard plastic grocery sacks when said standard plastic grocery sacks are opened and expanded." As similarly stated above, plastic sacks analogous to the ones used in grocery stores are made of different base perimeters and collar heights, therefore it cannot be determined what base perimeter and collar height dimensions are required by applicant's claims. Again, it is apparent that one of ordinary skill in the art would recognize that there is some limit to the base perimeter and collar height dimensions included in these claims, but would not be able to determine, with any degree of certainty or precision, the particular limits of the base perimeter and collar height recited in the claims so as to ascertain the metes and bounds of the claims.

Claims that have not been specifically mentioned are rejected since they depend from claims rejected under 35 U.S.C. § 112, second paragraph.

Art Unit: 3727

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-7 and 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art.

Applicant admits that placing a paper liner within a "standard plastic grocery sack" is old and well known. However, a paper liner whose base and height are "approximately equal" to that of an expanded "standard plastic grocery bag" is not found. It would have been an obvious matter of design choice to make the admitted prior art paper liner with base and height dimensions that are approximately equal to a standard plastic grocery bag (this includes those dimensions recited in claims 3-7, 10 and 14-17), since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 7 and 13, the admitted prior art discloses the claimed invention, as discussed above, except for the grade of the paper liner being between 35 lbs. and 50 lbs.. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a grade of paper between 35 lbs. and 50 lbs. for the admitted prior art paper liner, since it has been held to be within the general skill of a

Art Unit: 3727

worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Response to Arguments

6. Applicant's arguments filed 3/3/03 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion in the admitted prior art that a special paper liner be made for use as a liner of standard plastic grocery sacks, or as to how a special liner might be different than the standard paper sack, applicant is reminded that claims 2-7, 10 and 12-17 are solely directed to a paper sack. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Moreover, the recitation that applicant's paper sack is a "liner for plastic grocery sacks" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

Applicant appears to be of the position that the *In re Rose* citation is not applicable to the present application because the result of *In re Rose* "was merely the

Art Unit: 3727

larger package. Here, the change in size of the liner allows it to be used as a liner much more effectively than the prior art grocery bag used as a liner." The Examiner disagrees. In re Rose involved making a package of appreciable size and weight so as to require (or be more *effective* for) handling by a lift truck whereas the prior art showed similar packages that could be lifted by hand. "We do not feel that this limitation is patentably significant since it at most relates to the size of the article under consideration which is not ordinarily a matter of invention." In re Yount, 36 CCPA 775, 171 F.2d 317, 80 USPQ 141.

Regarding applicant's indication of "superior results" in the disclosure, the Examiner does not consider goals or "objects of the invention" that applicant has set up for himself to be a showing of results, let alone superior results. Furthermore, the selection of a lighter grade of paper by applicant to produce a less expensive paper sack does not yield superior results since applicant himself did not invent the less expensive paper. Regarding applicant's "realization that the advantages of both plastic and paper can be achieved by the use of a light weight paper liner in the plastic sack", it is not understood how this "realization" is a superior result that is applicable to claims 2-7, 10 and 12-17 that are solely directed to a paper sack.

Applicant's remarks are vague and confusing as to how "the explanation of the invention as an invention intimates the unexpected nature of the results." If applicant means the "Detailed Description of the Illustrated Embodiment", applicant is invited to specifically point out the showing of "intimated" unexpected results. Further, the providing of training and educational material by applicant is not a showing of

Art Unit: 3727

unexpected results. Applicant is just being an perceptive businessman providing competent customer service.

Applicant provides no argument that a person having ordinary skill in the art of paper sacks would not have found it obvious to use a grade of paper between 35 lbs. and 50 lbs. to form the paper sack of the admitted prior art other than the Examiner's alleged "use of impermissible hindsight". It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant's declaration of commercial success, filed 3/3/03, is still lacks the evidentiary as to applicant's market share. Therefore, the Examiner maintains that gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988). Applicant remarks that, "the fact shown by applicant's Declaration that significant sales have been made and continue to be made in the limited geographical market in which applicant has attempted to sell is the important indicator of commercial success." Merely showing that there was commercial success of an article which embodied the invention is not sufficient. *Ex parte*

Art Unit: 3727

Remark, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990). Finally, it is unclear how applicant's declaration of commercial success is applicable to claims 2-7, 10 and 12-17 which are directed to the paper sack alone and not the method in which they are used.

Conclusion

7. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 3727

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jes F. Pascua whose telephone number is 703-308-1153. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703-308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.



Jes F. Pascua
Primary Examiner
Art Unit 3727

JFP
April 30, 2003